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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/827,499 | 04/19/2004 | Heinrich Friederich | 00635.0371-US-01 | 3463 |

22865 7590 03/31/2005

ALTERA LAW GROUP, LLC
6500 CITY WEST PARKWAY
SUITE 100
MINNEAPOLIS, MN 55344-7704

EXAMINER

REESE, DAVID C

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 03/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|-----------------|-------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/827,499 | FRIEDERICH ET AL. | |
| | Examiner | Art Unit | |
| | David C. Reese | 3677 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 5-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This office action is in response to Applicant's amendment filed 2/14/2005.

Status of Claims

- [1] Claims 1-3, 5-10 are now pending.

Claim Objections

- [2] Applicant has addressed all objections to the Claims in the amendment filed 2/14/2005. Accordingly, the Examiner has withdrawn all objections to the claims.

Claim Rejections - 35 USC § 112

- [3] Applicant has addressed all rejections under 35 USC § 112 to the Claims in the amendment filed 2/14/2005. Accordingly, the Examiner has withdrawn the 35 USC § 112 rejections.

Response to Arguments

- [4] Applicant's arguments filed 2/14/2005 regarding rejections under 35 U.S.C. 102 have been fully considered but they are not persuasive. The argument surrounding claim 1 in that the spring element is adapted to prevent the pre-stressing effect for the screw connection being lost by virtue of changes in length thus ensuring sufficient frictional force to prevent the screw

connection becoming unscrewed is an example of intended use, stemming primarily from the word "adapted to". It has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Thus, the Examiner notes that the claim has been interpreted such that the language (see above) only requires that the prior art device be capable of performing the functions recited therein. Accordingly, Gustafson is believed to be capable of performing the amended statements as recited. That is, the spring element of Gustafson is capable of preventing the pre-stressing effect for the screw connection being lost by virtue of changes in length thus ensuring sufficient frictional force to prevent the screw connection becoming unscrewed.

Thus, in the instant case, the amended claim does not further limit the structure of the claimed invention, and the 102 rejection for Claim 1 based from Gustafson remains; as does the rejection for dependent claims 2-3 and 5-6.

[5] Applicant's arguments filed 2/14/2005 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. The argument continues from the basis of that discussed above, that is of the positive limitation set forth in Claim 1, following the "adapted to" statement. Further, as it is true that in certain circumstances, depending on the substrate by which the screw is being inserted, a "dig into" feature may be achieved, but however, this may only occur in one particular type of medium. In a different medium, a more hardened, smooth surface for example, and the head of the screw will be unable to "dig into" the medium, and then utilizing the spring element of the design of the head of the screw (which can and is indeed

considered as a ring with an angular work piece contact as shown in Fig. 2 of Gustafson) can be adapted to perform the functions listed in the last three lines of the first paragraph of amended claim 1. As a result of the above, the remaining claims (7-10) still stand under the 35 U.S.C. 103 rejections.

Conclusion

[6] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

[7] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is 703-305-4805. Due to a future move, however, this number will change after the 31st of March. After this date, the examiner can be reached at (571) 272- 7082. The examiner can normally be reached on 7:30 am - 5:00 pm M-Th, and every other Friday.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached on (703) 306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sincerely,
David Reese
Examiner
Art Unit 3677


ROBERT J. SANDY
PRIMARY EXAMINER